

REMARKS/ARGUMENTS

The final office action of December 1, 2006, has been carefully reviewed and these remarks are responsive thereto. Claims 20, 30-31, 34-35, 38-41, and 46-47 have been amended to place the claims in a more preferred form. Claims 22-23 and 44-45 have been canceled without prejudice or disclaimer. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-21, 27-43, and 46-47 remain pending.

Claims 1-23 and 27-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Birdwell et al. (U.S. Pat. No. 6,108,706, hereinafter referred to as *Birdwell*) in view of Robinson (U.S. Pat. No. 6,618,585, hereinafter referred to as *Robinson*). Applicants respectfully traverse.

In order to establish a *prima facie* case of obviousness under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

With respect to Applicants' claim 1, even if the references were combined, the combination still would not teach or suggest all the claim features. As admitted by the Action, *Birdwell* does not "explicitly disclose requesting, via the first network, further information from the computer network, wherein the further information is based on the received identifier; and receiving the further information via one of the first or second network." (Action, p. 2). To support this deficiency of *Birdwell*, the Action relies on column 3, line 42 to column 4, line 20 of *Robinson*.

The cited portion of *Robinson* describes an Internet enabled broadcast receiving apparatus that includes two modes of operation. (Col. 3, ll. 42-47). In a first mode of operation, the apparatus operates as a conventional public broadcast receiving device. (Col. 4, ll. 1-8). Under *Robinson*, in this first mode of operation, the apparatus may only receive data from the public broadcast. In a second mode of operation, a user can select an Internet broadcast channel for reception from one or more menus on the device. (Col. 4, ll. 9-12). Once a specific channel

has been selected, a controller causes a signal to be sent to request receipt of the selected channel and the received signal is then presented to a user. (Col. 4, ll. 12-20). The two modes of operation of *Robinson* are independent of each other.

Applicants' claim 1 recites, among other features, "requesting, via the first network, further information from the computer network, wherein the further information is based on the received identifier." Applicants respectfully disagree that *Robinson* teaches or suggests this feature of claim 1. As described above, *Robinson* describes two separate modes of operation. The Action appears to correlate the request for a specific Internet broadcast channel in *Robinson* to Applicants' requesting further information from the computer network. However, this alleged further information is not "based on the received identifier" that was received via the second network as in Applicants' claim 1. In *Robinson*, a user receives the listing of Internet broadcast channel options on her apparatus only when in the second mode of operation. Those options are received from the Internet broadcast network source, not a separate source from which the Internet broadcast channel is then selected. For at least the above-stated reasons, Applicants submit that the combination of *Birdwell* and *Robinson* fails to teach or suggest each and every feature of Applicants' claim 1. As such, Applicants' claim 1 is allowable over the art of record and Applicants respectfully request the withdrawal of the rejection.

Still further, even assuming, without admitting, that the combination of *Birdwell* and *Robinson* does teach or suggest each and every feature of Applicants' claim 1, there is no proper motivation for combining the two references. The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Applicants contend that there is no motivation or suggestion to combine *Birdwell* with *Robinson*.

The Action provides its motivation to combine stating, "[a]t the time the invention was made it would have been obvious to one in the ordinary skill in the art to incorporate requesting information based on received identifier via first or second network as disclosed by *Robinson* in the method of accessing information on a computer network on a communication device as disclosed in *Birdwell* to make the device more versatile and flexible resulting in reliable multi-

connectivity to a communications networks.” (Action, p. 3, emphasis added). Moreover, the purported motivation is a bare conclusion that has apparently been reached after having benefited from reading Applicants’ own disclosure, and is thus impermissible hindsight. Applicants find no motivation to combine the references.

Applicants respectfully submit that there is no motivation or suggestion to combine *Birdwell* with *Robinson*. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Action provide any evidence that the combination includes knowledge other than that gleaned from Applicants’ disclosure. Applicants respectfully request the Examiner to provide such motivation

In addition and in response to Applicants’ arguments in the Amendment filed September 15, 2006, the Action alleges that Figure 3 of *Birdwell* shows “an example of announcements (i.e. sending of information about some information) being sent over a network to the selected users” as describing Applicants’ claim 1 feature, “further information from the computer network, wherein the further information is based on the received identifier.” (Action, p. 7). Applicants respectfully disagree.

Figure 3 of *Birdwell* is described as “exemplary steps in a method for announcing delivery of upcoming data transmissions over a broadcast network.” (Col. 5, ll. 47-49). The description of Figures 3 is found from column 5, line 47 to column 6, line 31. The entire specified portion fails to teach or suggest anything regarding “wherein the further information is based on the received identifier.” *Birdwell* discloses a set of content servers 22, a bidirectional data network 28, a unidirectional broadcast network 30, and a set of clients 24. (Fig. 1; col. 3, ll. 10-16; col. 3, ll. 23-31). Announcements are submitted by the content servers 22 over the data network 28 to inform the clients 24 of upcoming data transmissions that will be broadcast at a future time over the broadcast network 30. (Col. 5, ll. 5-8).

The announcements in *Birdwell* include information such as identification of the sender, URL, channel, frequency, broadcast time, and broadcast protocol; the clients 24 use this information and launch a receiving application 64 to receive the data transmission at the appropriate time. (Col. 5, ll. 15-20 and 40-46). The clients 24 may also use a filter to determine

whether announcements meet certain criteria that are of interest. (Col. 5, ll. 26-39).

Importantly, *Birdwell* describes how the clients 24 do not (and cannot) request the future broadcasts over unidirectional broadcast network 30:

The clients are unable to reply or initiate communication to the broadcast center 26 using the broadcast network 30. *Birdwell*, col. 3, ll. 29-31 (emphasis added).

Rather than the clients requesting particular data from the servers, as is customary in conventional data networks but cannot be supported by unidirectional broadcast networks, the servers tell the clients through the announcements what data will be served over the broadcast network at a given time and how to find that data. *Birdwell*, col. 5, ll. 8-14 (emphasis added).

Nor does *Birdwell* teach or suggest that the network would respond by providing the future broadcast based on any supposed request by the clients 24. To the contrary, the future broadcast will occur only according to the schedule. Thus, *Birdwell* operates in a manner similar to how one typically programs a VCR to record a television show at a pre-scheduled time; a schedule is broadcast and the VCR is set to record at the scheduled time on the scheduled channel.

Claim 1 is therefore allowable over the combination of *Birdwell* and *Robinson* for at least the reasons discussed above. Applicants' claims 2-8 and 27-31, which depend on claim 1, are patentably distinct over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

Like claim 1, Applicants' independent claim 9 also recites "the further information is based on the received identifier." Thus, for at least similar reasons as explained above with respect to Applicants' claim 1, Applicants' claim 9 is patentably distinct over the combination of references.

Applicants' claims 10-23 and 32-47, which depend on claim 9, are patentably distinct over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. If any additional required fees are or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,
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